<center>**REMARKS**</center>

Claims 1-53 are pending in the case. The Office Action rejected each of claims 1-53 as follows:

- claims 1, 2, 4-8, 10-11, 18, 20-23, 28, 30-33 and 38-43 as being anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,836,884 ("Evans *et al.*");

- claims 12, 15-17, 24, 27 and 44-53 as being anticipated under 35 U.S.C. §102(b) by U.S. Letters Patent 6,138,271 ("Keeley");

- claims 3, 9, 19, 29 and 41 as obvious under 35 U.S.C. §103(a) by Keeley;

- claims 13, 14, 25 and 26 as obvious under 35 U.S.C. §103(a) by Evans *et al.* in combination with U.S. Publication No. 2002/0087916 ("Meth");

- claims 34-36 as obvious under 35 U.S.C. §103(a) by Evans *et al.* in combination with U.S. Publication No. 2002/0016953 ("Sollich"); and

- claim 37 as obvious under 35 U.S.C. §103(a) by Evans *et al.* in combination with Sollich and further in view of Keeley.

Applicants traverse each of the rejections.

I.   RESPONSE TO SUBSTANTIVE MATTERS

**A.   CLAIMS 1-12, 15-24, 27-33 AND 38-53 ARE NOVEL
        OVER EVANS *ET AL.***

The Office rejected claims 1, 2, 4-8, 10-11, 18, 20-23, 28, 30-33 and 38-43 as being anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,836,884 ("Evans *et al.*"). To anticipate, Evans *et al.* must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). Evans *et al.* fails to do this if it is construed properly.

1.   Claims 1, 2, 4-8, 10-11, 28, 30-33 & 38-43

Each of the independent claims 1, 8, 28, and 38 recites that the "waypoint" be defined "during the editing of the source code program". Each of the dependent claims 2, 4-7, 10-11, 30-

33 and 39-43 incorporates this limitation as a matter of law by virtue of their dependence. 35 U.S.C. §112, ¶4. Evans *et al.* fails to teach either a "waypoint" or the temporal limitation on its defintion.

The Office exclusively cites col. 2, lines 38-52, for anticipating the entire claim. This passage, in its larger context reads as follows:

> *While program execution is suspended, the user may modify or edit one or more portions of the source code component, and resume execution of the program at the point where execution was suspended.* Resuming execution may include compiling the edited source code component using a source compiler associated with the debugger application to create an edited intermediate language component, and compiling the edited intermediate language component using the intermediate language (e.g., JIT) compiler to create an edited native code component, which may then be executed from the point where program execution left off. Compilation of the edited intermediate language component may be done on an as-needed basis in order to reduce the time needed to resume execution of the edited program. In addition, the as-needed compilation avoids unnecessary compiling where an edited portion of the program, such as a method, is not called subsequent to the point where execution is restarted. The invention thus advantageously allows a software developer to interactively execute portions of the code, make revisions or changes, and continue execution without having to restart the program execution from the beginning after each edit.

(col. 2, lines 31-52, emphasis added)

Again, the Office has failed to actually map the language of the claims onto this passage contrary to its obligation to do so. *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990) ("...it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.") Consequently, Applicants are left to guess at how the Office maps this language onto the language of the claims. Should the guess miss the mark, Applicants request clarification and an opportunity to respond prior to a "final" rejection.

The Office presumably equates the recited "waypoint" with the point at which execution is suspended and then resumed. Thus, it becomes immediately apparent that the supposed "waypoint" is defined *during execution rather than during editing*. The first sentence of the quoted passage confirms that this point is defined during execution and the subject claims clearly

recite that the waypoint be defined during an editing session. Accordingly, Evans *et al.* fails to teach the temporal limitation.

It is true that the quoted passage discusses an editing session during suspended execution. It also states that compilation may be performed multiple times prior to resuming execution. However, nowhere does it describe a "waypoint" being defined during the editing session that. The only description of how the "portion of the source code program" compiled during the editing session is determined is that it comes at the point execution is suspended. And that point is determined during execution, not during editing. Evans *et al.* therefore fails to anticipate any of claims 1, 2, 4-8, 10-11, 18, 20-23, 28, 30-33 and 38-43. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

2.   **Claims 18 & 20-21**

Independent claim 18 recites "compiling a portion of the source code program *whose lower bound is defined by the identified waypoint*" (emphasis added). Dependent claims 20-21 incorporate this limitation as a matter of law by virtue of their dependence. 35 U.S.C. §112, ¶4. Evans *et al.* does not teach this limitation.

As noted above, the Office cites col. 2, lines 38-52 for teaching this limitation but fails to map it back onto the claim language as required by *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) at 1462. However, the only thing that can remotely be identified as creating a bound on the code to be compiled is the point at which execution is suspended. This point, even if erroneously construed as a "waypoint", the suspension point defines an *upper*, not lower, bound on the code. Evans *et al.* therefore does not teach the subject limitation and fails to anticipate any of claims 18 and 20-21. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

3.   **Claims 22-23**

Independent claim 22 recites that the method is one for "resuming compiler execution of a suspended compilation". Dependent claim 23 incorporates this limitation as a matter of law by virtue of its dependence. 35 U.S.C. §112, ¶4. Evans *et al.* does not teach this limitation. As noted above, the Office cites only col. 2, lines 38-52 for teaching this limitation but fails to map it back onto the claim language as required by *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) at 1462.

However, there is nothing in the cited passage about a "suspended compilation". Accordingly, Evans *et al.* does not teach the subject limitation and fails to anticipate any of claims 18 and 20-21. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

B.   CLAIMS 12, 15-17, 24, 27 & 44-53 ARE NOVEL OVER KEELEY

The Office rejected claims 12, 15-17, 24, 27 and 44-53 as being anticipated under 35 U.S.C. §102(b) by U.S. Letters Patent 6,138,271 ("Keeley"). To anticipate, Keeley must disclose every limitation of the rejected claim in the same relationship to one another as set forth in the claim. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990). Keeley fails to do this if it is construed properly.

1.   Claims 12, 15-17, 24, and 27

Independent claims 12 and 24 recite "a file reader portion of the compiler". Claims 15-17 and 27 incorporate this limitation as a matter of law by virtue of their dependence. 35 U.S.C. §112, ¶4. The Office cites col. 6, lines 24-29 as teaching the subject limitation of the respective elements. This passage reads:

> For example an operation designated by the name 40 "F1" might be contained at a module 44 at a defined set of instructions following a header F1. Of course it is not necessary that the operation 44 be contiguous provided its location can be defined.

However, F1 and the other modules 44 are a part of the operating system 18", which is separate from the compiler 56, as is clearly shown in Fig. 4 reproduced below.

Compilers are not operating systems—they are two distinct kinds of software as would be recognized by one of ordinary skill in the art. Thus, the Office has misconstrued Keeley. When *properly* construed, Keeley fails to teach the limitation and therefore fails to anticipate any of calims 12, 15-17, 24 and 27. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).
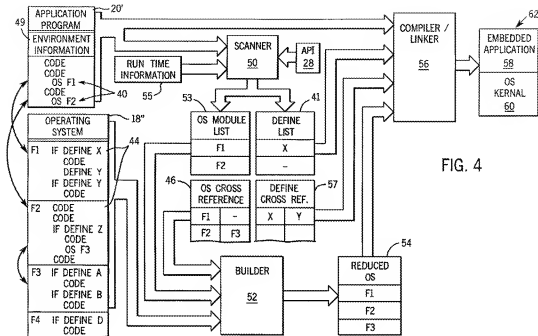
FIG. 4

Application Program (49, 20'), Environment Information, Code, Code OS F1, Code OS F2 (40, 55), Run Time Information (53), Scanner 50, API 28, Compiler / Linker 56, Embedded Application 58, OS Kernal 60 (62)

Operating System (18", 44): F1 IF DEFINE X CODE DEFINE Y CODE IF DEFINE Y CODE; F2 CODE CODE IF DEFINE Z CODE OS F3 CODE; F3 IF DEFINE A CODE IF DEFINE B CODE; F4 IF DEFINE D CODE

OS Module List (F1, F2) — Define List (X, –) (41)

OS Cross Reference (46): F1 –, F2 F3 — Define Cross Ref. (57): X Y, X Y

Builder 52 — Reduced OS 54: F1, F2, F3

2.   **Claims 44-53**

Independent claim 44 recites "compiling the identified instructions *while the file is being edited*" (emphasis added). Independent claims 45-49 incorporate this limitation as a matter of law by virtue of their dependence. 35 U.S.C. §112, ¶4. Independent claim 50 recites "compiling the portion defined by the upper and lower bounds *during an editing session...*" (emphasis added). Dependent claims 51-53 incorporate this limitation as a matter of law by virtue of their dependence. *Id.*

Keeley fails to teach the temporal limitation. The Office cites col. 6, lines 36-45 for teaching all of claim 44. This passage reads:

> Within each operation of the uncompiled operating system 18" are conditional compilation instructions of the form "IF DEFINE X" which provide instructions to the compiler as to whether the instructions following the IF DEFINE statement are to be compiled or discarded in the compilation. Such conditional compilations instructions are well known in the art and are conditional on define flags (the X in the IF DEFINE X form above) which are provided to the compiler. The modular nature of the operating system (e.g., divisions between F1 and F2) and the

use of conditional compilations instructions by the define flags
allows the operating system to be divided very finely.

Nothing in this passage indicates that the "selective compilation" (*see* col. 6, lines 30-35) occurs "while the file is being edited" or "during an editing session". Accordingly, Keeley does not teach the subject limitation and fails to anticipate any of claims 44-53. M.P.E.P. § 2131; *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

C. THE REMAINING CLAIMS ARE UNOBVIOUS OVER THE ART OF RECORD

All the remaining rejections are for obviousness over varying combinations of Evans *et al.* and/or Keeley and some combination with secondary references:

- claims 3, 9, 19, 29 and 41 over Keeley;
- claims 13, 14, 25 and 26 over Evans et al and Meth;
- claims 34-36 over Evans *et al.* and Sollich; and
- claim 37 over Evans et al, Sollich and Keeley.

To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 706.02(j); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Each of these rejections relies upon the primary reference to teach all the limitations of the independent claims from which these claims depend. The primary references Evans *et al.* and Keeley fail to do so. Accordingly, they, in combination with the secondary references, do not teach all the limitations of the claims. Accordingly, claims 3, 9, 13-14, 19, 25-26, 29, 34-37 and 41 are not obvious over the art of record.

II.   CONCLUDING REMARKS

Applicants therefore respectfully submit that the claims are in condition for allowance, and requests that they be allowed to issue. The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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